

REMARKS

The applicant respectfully requests entry of the foregoing amendment and reconsideration of claims 31-32, 40-46, 66-68 and 76 in view of the foregoing amendment.

A. Claim 66 is subject to a rejection under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Specifically, the phrase “at least one helical elevation pattern” is alleged to be “new matter.” The applicant respectfully disagrees with this characterization, but is willing to delete this phrase from the claim.

Accordingly, the present amendment removes the phrase, replacing it with “a helical elevation pattern” for consistency with other claims defining that feature, e.g. claim 42.

B. Claims 31-32, 40-46, 66-68 and 76 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite.

Specifically, use of the word “pitch” in independent claims 31, 43 and 66 is said to be in conflict with dependent claim 34 and certain other dependent claims which, as confirmed by the examiner in the present action, are claims 39, 49, 71 and 75.

The present amendment cancels dependent claims 34, 39, 49, 71 and 75.

C. Claims 31-32, 40-41, 43-46, 66-68 and 76 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,725,547 (Chuter).

The description of the Chuter patent provided in the previous (March 2005) amendment is incorporated by reference herein. The accompanying reasons in the previous amendment, distinguishing various claims from the Chuter reference, are hereby reasserted.

Independent claims 31 and 43 have been amended to more clearly provide that each of the first pitch and the second pitch is substantially constant. This serves to clarify and emphasize a substantial departure from the Chuter patent.

With respect to independent claim 66, the examiner is respectfully requested to recognize the distinction between an “elevation” and an “elevation pattern,” which is explained in the present specification. Claim 66 clearly defines the prosthesis as incorporating elevations

arranged in a helical elevation pattern on the tubular mesh wall. It is the elevation pattern - not an elevation - that is claimed as “helical.”

The examiner relies on Chuter’s alleged disclosure of “an elevation 24,” stating with respect to claim 66 that “one can select a wall segment such that the elevation 24 is ‘helical’ relative to the selected segment.” (action, p. 5).

This both ignores and contradicts the teachings of Chuter. Note that the Chuter specification teaches that multiple individual stent limbs “define a series of rings of transversely oriented sections (24) and longitudinally oriented sections (26).” (col. 4, lines 63-64, emphasis added). See also Figure 1.

If the examiner is convinced that a wall segment can be chosen to provide a helical elevation, he is respectfully requested to demonstrate how this is done.

In summary, with the specific reference to the examiner’s argument, claim 66 is patentable over Chuter because:


1. There is no manner of selecting a wall segment of the Chuter device to yield a helical elevation; and
2. Assuming arguendo that such manner of selecting is possible, is accomplished without hindsight reliance on the applicant’s disclosure, and actually yields a helical elevation, the result is immaterial due to the failure to teach or suggest a helical elevation pattern.

To summarize, claims 31-32, 40-46, 66-68 and 76 incorporate subject matter allowable over the prior art of record, and define that subject matter with clarity and precision in accordance with 35 U.S.C. § 112, second paragraph. The present amendment contains no subject matter beyond that of the original disclosure, does not touch the merits of the application, nor does it require further consideration or searching on the part of the examiner. Rather, it places the claims in condition for allowance, or in better form for consideration on appeal.

Therefore, the applicant respectfully requests entry of the present amendment, and favorable consideration of the pending claims in view of that amendment.

Respectfully submitted,
Boston Scientific Scimed, Inc.

Dated: September 26, 2005

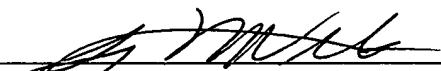
By: 
Frederick W. Niebuhr
Registration No. 27,717

Customer No. 23452

CERTIFICATE OF MAILING

Pursuant to 37 CFR 1.8, I hereby certify that this Amendment Pursuant to 37 CFR 1.116 in Application Serial No. 10/674,729 is being deposited with the U.S. Postal Service by first class mail, postage prepaid, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of deposit indicated below.

Date of Deposit: September 26, 2005


GERALYN M. VITA

1029419.1